

REMARKS

The Office Action of April 15, 2005, has been considered by the Applicants. A Request for Continued Examination ("RCE") is also being filed in conjunction with this Preliminary Amendment. Claims 1, 27, 28, 30, and 31 have been amended. Claims 10-12 have been cancelled. Claims 1-8, 13-21, and 23-31 remain pending. Reconsideration of the Application is requested.

Claims 1-8, 10-21, and 23-31 were rejected under 35 U.S.C. 112, first paragraph, as failing the written description requirement. Applicants traverse the rejection.

The independent claims have been amended to recite the conductive polymer is present in an amount of "about 0.1 percent" by weight of the polymer coating. Support for this limit may be found at page 10, lines 5-8, of the specification. Applicants take the position that the endpoints of the disclosed range are sufficiently described. Support for this position may be found in the discussion of *in re Wertheim* in MPEP § 2163.05(III). Applicants believe one skilled in the art would consider the endpoints inherently supported by the discussion in the original disclosure. Withdrawal of the written description rejection is requested.

Claims 1-8, 10-21, and 23-31 were rejected under 35 U.S.C. 112, first paragraph, as indefinite. This rejection was based on the usage of the term "below about 5" weight percent. As this language has been removed from the claims, this rejection is moot. Withdrawal of the rejection is requested.

Claims 1-6, 10-21, 23, 24, and 26-31 were rejected under 35 U.S.C. 102(b) as anticipated by Drappel (US 6,391,509). Claims 1-8, 10-21, 23, 24, and 26-31 were rejected under 35 U.S.C. 103(a) as obvious over Drappel. Applicants traverse the rejections together.

It is clear that the point of argument between the Examiner and Applicants has to do with Drappel's teaching a lower limit of about 5 wt% conductive polymer in the polymer coating. Drappel does not teach the conductive polymer is about 0.1 wt% of the polymer coating; therefore, he does not anticipate.

Drappel does not render the instant claims obvious. Applicants submit that one skilled in the art would not read Drappel and expect that a carrier with about 0.1 wt% conductive polymer in the polymer coating would be useful for the purposes given by Drappel. With regards to the Examiner's citation of MPEP § 2144.05, Drappel's range does not overlap the claimed amount (0.1 wt%). Because the claimed amount is not within the prior art, it would not be found by optimization. MPEP § 2144.05(A) and (B) would therefore not apply. A practical distinction can be made between Drappel and the instant claims and it would not be expected that their carriers should have the same properties. For this reason, withdrawal of the rejection is requested.

Claim 25 was rejected under 35 U.S.C. 103(a) as unpatentable over Drappel in view of Viswanathan (US 6,764,617). Applicants traverse the rejection.

Viswanathan does not correct the deficiency in the amount of conductive polymer present in the polymer coating. Therefore, a *prima facie* case of obviousness does not exist. Withdrawal of the rejection is requested.

CONCLUSION

For the above reasons, it is submitted all pending claims (claims 1-8, 13-21, and 23-31) are in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

Respectfully submitted,
FAY, SHARPE, FAGAN, MINNICH
& McKEE LLP


Richard M. Klein (Reg. No. 33,000)
1100 Superior Avenue, 7th Floor
Cleveland, OH 44114
(216) 861-5582